

REMARKS

Claims 1–20 are pending in the present application.

Claims 1-4 and 6-20 were rejected.

Claim 5 was objected to.

Reconsideration of the claims is respectfully requested.

35 U.S.C. § 112 (Indefiniteness)

In sections 3 and 4 of the Office Action of June 30, 2003, Claim 9 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. This rejection is respectfully traversed.

Claim 9 has been amended to correct a typographical error and to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Accordingly, the Applicants respectfully request withdrawal of the 35 U.S.C. § 112 rejection of Claim 9.

35 U.S.C. § 103 (Obviousness)

In section 6 of the Office Action of June 30, 2003, Claims 1–4, 6–8, 11 and 17-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,275,531 to Li (“Li”). The Applicants respectfully traverse this rejection.

As an initial matter, the Applicant respectfully notes that the Office Action Summary lists Claims 12-16 as having been rejected, however no specific explanation is given in the Detailed Action for the rejection. The Applicants assume that Claims 12-16 were rejected under 35 U.S.C. § 103(a) along with Claim 1, from which they depend.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness,

three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Regarding independent Claims 1, 7 and 11, the Office Action asserts that the claimed “predetermined number of frames” is found in *Li*'s N number of enhancement layer data. *Office Action*, p. 3. The Applicants respectfully assert that enhancement layers are not frames.

The *Li* reference characterizes the N number of enhancement layers at Col. 3, lines 9-16:

The improved quality and scalability are achieved by a method wherein an enhancement layer is subdivided into layers or levels of bitstream layers. Each bitstream layer is capable of carrying information complementary to the base layer information, in that as each of the enhancement layer bitstreams are added to the corresponding base layer bitstreams the quality of the resulting images are improved.

The N number of enhancement layer bitstreams are encoded from the video input based on the base layer bitstream. *Li*, column 3, lines 52-57. The video input is described as “a sequence of video frames, each frame being a still image.” *Li*, column 1, lines 50-51. Thus, frames are subdivisions of the enhancement layer bitstreams.

The *Li* reference teaches the method of adapting to reductions in the bandwidth of the transmission channel by transmitting fewer than all N number of enhancement layers to. *Li*, column

5, line 57, to column 6, line 7. As a result, *Li* fails to disclose, teach, or suggest the Applicants' claimed "predetermined number of frames" as recited in Claims 1, 7 and 11 (and Claims 2-4, 6, 8 and 12-20 depending therefrom).

Accordingly, the Applicants respectfully request withdrawal of the 35 U.S.C. § 103 rejection of Claims 1-4, 6-8 and 11-20.

In section 7 of the Office Action, Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Li* in view of U.S. Patent No. 5,742,892 to Chaddha (*Chaddha*). The Applicants respectfully traverse this rejection.

As described above, the *Li* reference fails to disclose, teach, or suggest the claimed "predetermined number of frames." The *Chaddha* reference is not cited by the Office Action as disclosing, teaching, or suggestion this element of Claims 9 and 10. As such, the Office Action fails to establish that the proposed *Li-Chaddha* combination discloses, teaches, or suggests the Applicant's invention as recited in Claims 9 and 10.

Accordingly, the Applicants respectfully request withdrawal of the 35 U.S.C. § 103 rejection of Claims 9 and 10.

Allowable Subject Matter

Applicants gratefully acknowledge the Examiner's indication in paragraph 8 of the June 30, 2003, Office Action that Claim 5 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As described above, Applicants believe that they have overcome the rejections made in section 6 of the Office Action.

SUMMARY


For the reasons given above, the Applicant respectfully requests reconsideration and allowance of pending claims and that this Application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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